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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/265,710	03/09/1999	OLGA BANDMAN	PF-0339-1DIV	4844

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EXAMINER

ULM, JOHN D

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 05/07/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/265,710**

Applicant(s)  
**Bandman et al.**

Examiner  
**John Ulm**

Art Unit  
**1646**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 28, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 12, 21, and 42-57 is/are pending in the application.
- 4a) Of the above, claim(s) 46, 47, and 52-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 12, 21, 42-45, and 48-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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- 1) Claims 1, 2, 12, 21 and 42 to 57 are pending in the instant application. Claim 21 has been amended as requested by Applicant in Paper Number 19, filed 28 February of 2002.
- 2) Any objection or rejection of record which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.
- 3) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- 4) Claims 46, 47 and 52 to 57 stand withdrawn from consideration as being directed to a non-elected invention for those reasons of record in section 5 of Paper Number 17. See 37 CFR 1.142(b) and MPEP § 821.03.
- 5) Claims 1, 2, 12, 21, 42 to 45 and 48 to 51 stand rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible, substantial and specific asserted utility or a well established utility for those reasons of record in section 7 of Paper Number 17. Applicant's traversal of this rejection on the premise that the claimed polypeptides are useful as tools for toxicology testing, drug discovery, and the diagnosis of disease has been presented earlier and answered at length.

The declaration by Lars Furness under 37 CFR 1.132 filed 28 February of 2002 is insufficient to overcome the rejection of claims 1, 2, 12, 21, 42 to 45 and 48 to 51 based upon a lack of specific and substantial utility as set forth in the last Office action because it merely presents Applicant's arguments of record in declaratory form, such arguments having already been answered on the record.

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6) Claims 1, 2, 12, 21, 42 to 45 and 48 to 51 are rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

7) Claims 2, 21, 42, 44, 45, 48, 50 and 51 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for those reasons of record in section 6 of Paper Number 7. Applicant essentially argues that one of ordinary skill in the art could readily recognized that they were in possession of a protein encompassed by the instant claims by the fact that the protein under consideration meets the limitations recited therein. To the contrary, if one were presented with an isolated protein having an amino acid sequence which is at least 90% identical to SEQ ID NO:1 of the instant application they would not be able to determine if it was encompassed by the instant claims by reviewing the description of the claimed genus which is presented in the instant specification. Of the tens of thousands of material embodiments of proteins encompassed by the limitation "polypeptide having at least 90% amino acid sequence identity to SEQ ID NO:1", only a tiny percentage would also be expected meet to limitation "naturally occurring polypeptide". Because the instant specification does not describe that structural feature or combination of features which distinguishes a polypeptide which meets both of these limitations from a polypeptide which meets only the first limitation, the instant

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specification does not provide an adequate written description of the claimed genus of polypeptide.

8) Applicant's arguments filed 28 February of 2002 have been fully considered but they are not persuasive for those reasons given above.

9) **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10) This application contains claims 46, 47 and 52 to 57, which are drawn to an invention nonelected with traverse in Paper No. 19. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

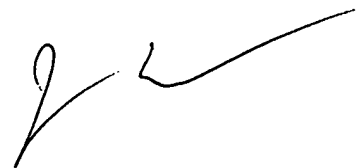
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242 or (703) 872-9306. Official responses under 37 C.F.R. § 1.116 should be directed to (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



**JOHN ULM**  
**PRIMARY EXAMINER**  
**GROUP 1800**